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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN R. McCLAIN, DAVID T. NAY
and WILLAM VIGILANTE, JR.

Appeal 2008-1775
Application 10/776,943
Technology Center 3600

Decided: August 28, 2008

Before JENNIFER D. BAHR, JOSEPH A. FISCHETTI and DANIEL S. SONG, *Administrative Patent Judges*.

SONG, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

The Appellants appeal under 35 U.S.C. § 134 (2002) from a Final Rejection of claims 1, 5, 10, 11 and 21-23. Claims 4, 6, 8 and 13-20 stand withdrawn from consideration. Claims 2, 3, 7, 9 and 12 have been previously canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

The Appellants claim an apparatus for storing computing devices on a computer equipment rack such that an upper support and a lower support of the apparatus can be transitioned to a vertical storage position (Specification 5: ¶ [013]).

The sole independent claim reads as follows:

> 1. An apparatus for compactly storing computing devices, comprising:
>
> an upper support comprising a rigid material forming a planar vertical back with substantially perpendicular edge protrusions along planar vertical back edges and configured to receive a display device;
>
> a lower support comprising a rigid material forming a tray configured to receive a keyboard and an integrated pointing device; and
>
> a mounting mechanism that connects the upper support to the lower support and allows the upper support and the lower support to transition between an access position and a vertical storage position, the mounting mechanism mounted to a computer equipment rack such that the vertical storage position is outside of the computer equipment rack and places the upper support and lower support behind a face of the computer equipment rack, wherein the computer equipment rack is configured to mount equipment with a height that is an integer multiple of 44.45 millimeters and the face is configured as a virtual vertical plane of the computer equipment rack wherein a user may access equipment mounted within the computer equipment rack.

The prior art relied upon by the Examiner in rejecting the claims is:

Harbin	US 6,286,794 B1	Sep. 11, 2001
Oddsen, Jr.	US 6,783,105 B2	Aug. 31, 2004

Felcman US 6,945,412 B2 Sep. 20, 2005

The Examiner rejected claims 1, 5, 10, 11 and 22 under 35 U.S.C. § 102(b) as lacking novelty over Harbin.

The Examiner rejected claim 21 under 35 U.S.C. § 103(a) as unpatentable over Harbin.

The Examiner also rejected claims 1, 5, 22 and 23 under 35 U.S.C. § 103(a) as unpatentable over Felcman and Oddsen.

We AFFIRM-IN-PART.

ISSUES

The following issues have been raised in the present appeal.

1. Whether the Appellants have shown that the Examiner erred in rejecting claims 1, 5, 10, 11 and 22 as lacking novelty over Harbin.

2. Whether the Appellants have shown that the Examiner erred in rejecting claim 21 as unpatentable over Harbin.

3. Whether the Appellants have shown that the Examiner erred in rejecting claims 1, 5, 22 and 23 as unpatentable over Felcman and Oddsen.

FINDINGS OF FACT

1. Harbin describes an apparatus for compactly storing computing devices 14, 58 including an upper support 16 for receiving a display device 74, a lower support 26 for receiving a keyboard 126, and a mounting mechanism 18, 24, 28 that connects the upper support to the lower support and allows the upper support and the lower support to transition between a

lowered position (i.e., an access position) and an elevated storage position (i.e., a vertical storage position) (Figs. 1 and 4; Col. 4, l. 59-Col. 5, l. 10; Col. 7, ll. 37-48).

2. Harbin describes mounting the mounting mechanism to a computer equipment rack (hollow column 38) which is configured to mount computer equipment 14, 58 (Fig. 1; Col. 4, ll. 62-Col. 5, ll. 10). Harbin also describes the upper support and lower support which are positioned outside of the computer equipment rack (Fig. 1).

3. Harbin further describes the mounting mechanism as mounted to a swivel bracket 32 which allows a rotational range of motion of the upper support and the lower support (Col. 6, ll. 48-55). In addition, further rotational range of motion is provided to the upper and lower supports by the provided swivels (Col. 6, ll. 55-65). Thus, Harbin describes a device in which the upper support and lower support can be positioned at least partially behind a face of the computer equipment rack, i.e., the column 38.

PRINCIPLES OF LAW

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their

broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art. In addition, "[i]t is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002)

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). In *KSR*, the Supreme Court explained that "[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *KSR,* 127 S.Ct. at 1740-41. The Court noted that "[t]o

facilitate review, this analysis should be made explicit." *Id.* at 1741, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"). However, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* at 1741.

ANALYSIS

Rejection of claims 1, 5, 10, 11 and 22 as lacking novelty over Harbin

The Examiner rejected these claims finding that Harbin describes each and every limitation[1] (Ans. 3). Initially, the Appellants contend that Harbin does not disclose "a mounting mechanism that allows an upper support and a lower support to transition between an access position and a vertical storage position" recited in independent claim 1 (Br. 7 and 9). In particular, the

[1] The Appeal Brief on page 16 asserts another issue to be reviewed on appeal is whether the Examiner properly considered the Appellants' argument made after final rejection regarding the anticipation rejection of claim 1 based on the Examiner's comment in the Advisory Action of October 27, 2006 (App. Br. 6 and 16). However, this issue is not within the jurisdiction of the Board and appears to be moot given the Examiner's clarifying remarks in the Examiner's Answer (Answer 13, 14) which the Appellants' Reply Brief (Reply Br. 12) acknowledges.

Appellants contend that Harbin merely describes changing the vertical height of the computer workstation that is in an access position, and does not describe the lower support and upper support assuming a vertical storage position (Reply Br. 3).

The Examiner responds that this limitation is met by the device of Harbin "being vertically cleared out of a work area while a user is performing other tasks" (Ans. 8). We agree. During prosecution, claims are to be given their broadest reasonable construction in light of the Specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). In addition, "[a]bsent claim language carrying a narrow meaning, the PTO should only limit the claim based on the specification or prosecution history when those sources expressly disclaim the broader definition." *In re Bigio*, 381 F.3d 1320, 1325 (Fed Cir. 2004).

However, the term "vertical" is defined by *Merriam-Webster's Collegiate Dictionary* (11th Ed., 2007) as "situated at the highest point," which occurs in Harbin when the upper support and the lower support are in an elevated storage position (i.e., a vertical storage position) (FF 1). In addition, there does not appear to be a specific definition of the term "vertical", or a disclaimer within the Specification of the broader definition of "vertical" which encompasses the vertical storage position described in Harbin. Thus, in view of the above, we agree with the Examiner that when broad construction of the term "vertical" is applied, the vertical storage position recited in these claims is described in Harbin.

The Appellants also contend that Harbin does not describe a computer equipment rack, stating that those in the art would not interpret the open track of Harbin as the recited "computer equipment rack" and that the definition of the term "rack" applied by the Examiner is overly broad (App. Br. 9; Reply Br. 3-5). However, we agree with the Examiner's position that the column 38 and the CPU tray 12 of Harbin serve as a framework or stand (i.e., a rack) for holding computer equipment (i.e., the CPU and/or data cables) (Ans. 8 and 9). We do not find the Appellants' argument asserting that "computer equipment rack" has an industry standard meaning which precludes Examiner's broad interpretation to be persuasive evidence (Reply Br. 5).

The Appellants also argue that Harbin does not describe a vertical storage position outside of a computer equipment rack which places the upper support and lower support behind a face of the computer equipment rack (App. Br. 9; Reply Br. 4). However, we note that the parallelogram arm assembly, as well as the upper and lower support of Harbin are pivotable, and thus, can be positioned so as to satisfy the recited limitation (FF 3).

The Appellants further contend that Harbin does not describe a computer equipment rack which is configured to mount equipment with a height that is an integer multiple of at least one of 44.45 millimeters (App. Br. 9; Reply Br. 6). However, the Examiner is correct in noting that the "equipment" having the recited height is not a required component of the claimed apparatus and that Harbin satisfies this limitation because the

column 38 and/or the CPU tray 12 of Harbin can support such equipment with the recited height dimension (Ans. 9). In this regard, we note that the Appellants' assertion that the Examiner is improperly ignoring limitations that further define and clarify the term "computer equipment rack" is misdirected because claim 1 merely recites that the rack is "configured to mount "equipment" that has the recited height dimension (Reply Br. 6; Ans. 9). In other words, the claim merely requires that the rack be capable of having such equipment mounted thereon. Hence, this limitation is satisfied by the column/CPU tray of Harbin which is capable of mounting such equipment.

In view of the above, the Appellants have failed to show that the Examiner erred in rejecting claim 1 as lacking novelty over Harbin. The Appellants do not argue the dependent claims 5, 10, 11 and 22 separately, but instead, merely rely on their ultimate dependency from claim 1 for patentability (App. Br. 9). Thus, these claims fall with independent claim 1 and the Appellants have not shown that the Examiner erred in rejecting these dependent claims as well. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Rejection of claim 21 as unpatentable over Harbin

The Examiner rejected claim 21 as unpatentable, finding that Harbin specifically teaches motorizing the travel of the carriage 24 and/or the dual parallelogram arm assembly 28 (Ans. 4 and 5). The Appellants contend that Harbin does not teach motorizing the transition between an access position and a vertical storage position (App. Br. 10 and Reply Br. 7). The

Appellants' position is again based on the argument that Harbin does not describe a vertical storage position (App. Br. 11 and Reply Br. 7). However, this line of reasoning is not persuasive as discussed *supra* in view of the definition of the term "vertical" (FF 2). As the Examiner noted, Harbin suggests motorizing the travel of the carriage 24/arm assembly 28 so that transitioning of the upper and lower supports between an access position and a vertical storage position (i.e., elevating the supports to be "situated at the highest point") is motorized. Thus, we agree with the Examiner that claim 21 is unpatentable over Harbin and find that the Appellants have failed to show that the Examiner erred.

Rejection of claims 1, 5, 22 and 23 as unpatentable over Felcman and Oddsen

The Examiner also alternatively rejected claims 1, 5, 22 and 23 as unpatentable over Felcman and Oddsen, finding that various deficiencies of Felcman's mounting system are cured by the adjustable display arm of Oddsen (Ans. 5-7).

The Appellants argue that there is no suggestion to combine Felcman and Oddsen in the manner suggested by the Examiner (App. Br. 15). While explicit teachings or suggestions in the references are not required, we agree with the Appellants that the Examiner's articulated reasoning is insufficient for us to conclude that the claimed invention would have been obvious to one of ordinary skill in the art.

Specifically, the Examiner finds that it would have been obvious to one of ordinary skill in the art to attach the mounting arm of Oddsen to the rack of Felcman (Ans. 7). The Examiner reasons that mounting the device of Felcman requires the use of internal space that could otherwise be used for additional hardware, and observes that Oddsen suggests storing components at an elevated level to save desktop space (Ans. 12). Thus, the Examiner concludes that it would be obvious to attach the adjustable arm assembly disclosed by Oddsen to either the frame member or a divider panel of the rack of Felcman in order to free up internal space within the rack of Felcman (Ans. 12).

However, we are not persuaded that a person with ordinary skill in the art would know to mount the adjustable arm assembly of Oddsen to the frame member or to the divider panel of the rack of Felcman.

The Examiner finds that the display arm of Oddsen being described as attached to a wall does not preclude the display arm from being attached to another surface such as the rack of Felcman (Ans. 13). While we agree with the Examiner's statement, it is not apparent how the combination results in the claimed invention. Combination of the teachings of Felcman and Oddsen would appear to result in either the display arm being mounted within the rack of Felcman, in a manner which would not be capable of providing a vertical storage position outside the rack, as required by the claims, or the display arm being mounted high on an adjacent wall surface via structure distinct from Felcman's rack (Oddsen; Col. 5, ll. 9-17), which again would not meet the requirements of the claims. While the Examiner

has articulated a rational reason for combining these references (Final 5, 6), the resulting combination would not meet the requirements of the claims.

In view of the above, we find that the Appellants have shown that the Examiner erred in rejecting independent claim 1 as unpatentable over Felcman and Oddsen. We therefore cannot sustain the rejection of claim 1, or claims 5, 22 and 23 that depend from claim 1.

CONCLUSIONS

1. The Appellants have not shown that the Examiner erred in rejecting claims 1, 5, 10, 11 and 22 as lacking novelty over Harbin.

2. The Appellants have not shown that the Examiner erred in rejecting claim 21 as unpatentable over Harbin.

3. The Appellants have shown that the Examiner erred in rejecting claims 1, 5, 22 and 23 as unpatentable over Felcman and Oddsen.

ORDERS

1. The decision to reject claims 1, 5, 10, 11, 21 and 22 is AFFIRMED.

2. The decision to reject claim 23 is REVERSED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

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